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WASHINGTON, DC 200075109

EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/258,407

Applicant(s)

CHEAITO ET AL.

Examiner

Simon Sing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 15, 17, 18, 28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Gurbani et al. US Patent 6,282,275.

1.1 Regarding claim 1, Gurbani discloses a telephone caller identification log with Internet access in figure 1. As shown in figure 1, a subscriber telephone 104 is connected to a telephone network PSTN 110. A caller ID server 124 [data logging unit] receives and stores caller identification information (column 2, lines 59-63; column 3, lines 4-8). The caller ID server 124 is connected to an Internet protocol network,

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allowing the subscriber to access caller identification information via Internet. Gurbani further discloses that a caller 102 may be connected to switched telephone network PSTN 110, via other switched telephone networks, such as an ISDN service, a wireless service, etc. (column 2, lines 38-41). Gurbani teaches that the PSTN contains a local switch (column 2, lines 42-44). Caller ID server 124, STP114 and SCP 122 are inherently in the subscriber's local switched telephone network.

1.2 Regarding claim 15, Gurbani teaches that a subscriber can access the caller identification information via a computer connected to Internet protocol server 126, which is an Internet service provider (column 3, lines 28-33). The subscriber inputs a user ID and a password in order to gain access to his database (column 3, lines 37-43).

1.3 Regarding claim 17, Gurbani discloses a telephone caller identification log with Internet access in figure 1. Gurbani teaches that a subscriber can access the caller identification information via a computer connected to Internet protocol server 126 (column 3, lines 28-33). The subscriber inputs a user ID and a password in order to gain access to his database (column 3, lines 37-43).

1.4 Regarding claim 18, Gurbani teaches using a caller ID server 124 to receive and store caller identification information (column 2, lines 59-63; column 3, lines 4-8). Gurbani further teaches that the PSTN 110 contains a local switch (column 2, lines 42-

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44). Caller ID server 124, STP114 and SCP 122 are inherently in the subscriber's local switched telephone network.

1.5 Regarding claims 28 and 30, Gurbani discloses a telephone caller identification log with Internet access in figure 1. Gurbani also discloses a caller IDs server 124 for receiving and storing caller identification information (column 2, lines 59-63; column 3, lines 4-8). Gurbani teaches using a computer to remotely access caller identification information via the Internet (column 3 lines 19-30). Gurbani further teaches using Internet telephony hardware and software to call back a caller by selecting and activating the number in the record (column 4, lines 7-16).

2. Claims 1, 2, 5, 9, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik US Patent No. 5,943,409.

2.1 Regarding claim 1, Malik discloses a system for providing automatic recall information in a telecommunication network in figure 1. Malik's system comprising:

a subscriber telephonic device (telephone 15b) connected to a subscriber switched telephone network; and

a data logging unit [line history block] (column 7, lines 32-36) in the subscriber switched telephone network (column 8, lines 54-60), the data logging unit storing caller identifying information upon a call to the subscriber telephonic device (column 7, lines 22-36) from a caller telephonic device (15a) in a caller switched telephone network, the

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data logging unit being connected to a network allowing a subscriber access the caller identifying information via the network (column 7, lines 37-45; column 8, lines 1-4; column 11, lines 15-17).

2.2 Regarding claim 2, the system of claim 1, wherein the subscriber switched telephone network and the caller switched telephone network are the same switched telephone network (figure 1).

2.3 Regarding claim 5, the system of claim 1, wherein the data logging unit (line history block) inherently includes a database for storing the caller identifying information, and wherein the database is local to a service signal point (SSP 25 b; column 7, lines 32-36) of the subscriber switched telephone network.

2.4 Regarding claim 9, the system of claim 1, wherein the data logging unit (line history block) inherently includes a database for storing the caller identifying information, and wherein the database is in SCP 50 (column 10, lines 27-29).

2.5 Regarding claims 11 and 12, the database of the data logging unit inherently comprises a storage medium for storing the caller identifying information (column 7, lines 32-36).

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3. Claims 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Rogers US Patent 5,946,386.

3.1 Regarding claim 15, Rogers discloses a call management system and voice mail system in figure 1. Rogers teaches accessing a user-accessible call-log, which stores call related information (column 42, lines 11-13 and 24-26), including caller IDs (column 23, lines 16-20; column 25, lines 18-24; figure 9), via a user computer remotely connected to the system through Internet (column 8, lines 53-58).

3.2 Regarding claim 16, as discussed in claim 15, Rogers teaches that the caller identifying information is accessed via a computer, which inherently, connected to Internet service provider.

3.3 Regarding claim 17, Rogers discloses a call management system and voice mail system in figure 1. Rogers teaches accessing a user-accessible call-log, which stores call related information (column 42, lines 11-13 and 24-26), including caller IDs (column 23, lines 16-20; column 25, lines 18-24; figure 9), via a user computer remotely connected to the system through Internet (column 6, lines 59-62; column 7, lines 13-19; column 8, lines 53-58). Inherently a subscriber, or user inputs a password in order to gain access to his account or database.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik US Patent No. 5,943,409 in view of Valentine US Patent 5,898,770.

4.1 Regarding claims 3 and 4, Malik discloses a data logging device in a subscriber switched telephone network for logging a caller identifying information.

Malik fails to specifically teach that the subscriber switched telephone network and the caller switched telephone network are two separate switched telephone networks and there is line connecting the two switched telephone networks for transferring the caller identifying information.

However, Valentine discloses a caller ID logging unit (CLD 100) for logging caller IDs (column 3, line 59 to column 4, line 7) in figure 1. Valentine teaches that his invention may be used in conjunction with any routing network, including SS7 (column 3, lines 33-41) and wireless (column 6, lines 27-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify to modify the Malik's reference with Valentine's teaching so that the line connecting the subscriber's switched telephone network and a caller's switched telephone network would have been a SS7 line or a wireless link,



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because such modification would have clarified the teaching of Malik and would have enabled a subscriber to received calls from other switched telephone networks.

4.2 Regarding claim 6, Malik discloses a data logging unit within SSP 25b connected to STP 35 and SCP 50. Malik also discloses that the caller identifying information may be stored in SCP 50 (column 10, lines 27-29). Malik fails to teach that the data logging unit is connected to an intelligent peripheral.

However, Valentine discloses a caller ID store 108 located in SCP 172 (column 5, lines 64-67), which is connected to an IP (figure 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Malik reference with Valentine's teaching so that the data logging unit would have been connected to an IP, and by inherency would have had a line peripheral for interconnection, because such modification was well within the teaching of Malik, since Malik taught placing the data logging unit in a SCP, and connecting a SDCP to an IP was a matter of design choice of an AIN switched telephone network.

5. Claims 7, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik US Patent No. 5,943,409 in view of Gurbani et al. US Patent 6,282,275.

Malik discloses a data logging unit comprises a database for storing caller identifying information, but fails to teach that data logging unit comprises a gateway connected to the Internet, wherein the database is accessible through the gateway.

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However, Gurbani discloses a telephone caller identification log with Internet access in figure 1. As shown in figure 1, a subscriber telephone 104 is connected to a telephone network PSTN 110. A caller ID server 124 [data logging unit] receives and stores caller identification information (column 2, line 45 to column 3, line 8). The caller ID server 124 is connected to an Internet protocol network, and inherently the caller ID server 124 has a gateway for connecting to the Internet for communicating with a user computer 130 (column 3, lines 39-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Malik reference with Gurbani's teaching so that the data logging unit would have comprised a gateway connected to an Internet, allowing a user to retrieve caller identifying information through a computer via the Internet, because such modification would have enabled a subscriber to access the caller identifying information from a telephone device or from a computer via Internet.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik US Patent No. 5,943,409 in view of Valentine US Patent 5,898,770 and further in view of Gurbani et al. US Patent 6,282,275.

The Malik reference, modified by Valentine, discloses a data logging unit comprises a database for storing caller identifying information, but fails to teach that data logging unit comprises a gateway connected to the Internet, wherein the database is accessible through the gateway.

However, Gurbani discloses a telephone caller identification log with Internet access in figure 1. As shown in figure 1, a subscriber telephone 104 is connected to a telephone network PSTN 110. A caller ID server 124 [data logging unit] receives and stores caller identification information (column 2, line 45 to column 3, line 8). The caller ID server 124 is connected to an Internet protocol network, and inherently the caller ID server 124 has a gateway for connecting to the Internet for communicating with a user computer 130 (column 3, lines 39-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Malik reference, which was modified by Valentine, with Gurbani's teaching so that the data logging unit would have comprised a gateway connected to an Internet, allowing a user to retrieve caller identifying information through a computer via the Internet, because such modification would have enabled a subscriber to access the caller identifying information from a telephone device or from a computer via Internet.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malik US Patent No. 5,943,409 in view of Miller et al. US Patent 4,930,152.

Malik discloses a data logging unit wherein a subscriber retrieves caller identifying information from a telephone device. Malik fails to teach that the telephone device is a remote telephone device.

However, Miller discloses a call return telephone service in figure 1. Miller also discloses a caller identifying logging device within a subscriber's switched telephone

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network in figure 5 (column 3, line 59 to column 4, line 8), wherein the caller identifying information is stored in memory 502 (column 5, lines 3-30). Miller teaches that a subscriber retrieves caller identifying information from a remote telephone (column 2, lines 21-51; figures 2-4, steps 201, 202, 206-211, 203, 204, 301, 302, 309, 401-404, 413).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Malik reference with Miller's teaching so that a subscriber would have been able to retrieve the caller identifying information from a remote telephone, because such modification would have enabled a subscriber to access the caller identifying information away from home via a remote telephone.

8. Claims 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers US Patent 5,946,386 in view of Gurbani et al. US Patent 6,282,275.

8.1 Regarding claim 18, Rogers teaches accessing a user-accessible call-log, which stores call related information via a user computer remotely connected to the system through the Internet. Rogers fails to teach that the user-accessible call-log [data logging unit] is within a switched telephone network.

However, Gurbani discloses a telephone caller identification log with Internet access in figure 1. A caller ID server 124 [data logging unit] within a switched telephone network (figure 1; column 5, lines 48-53) receives and stores caller identification information (column 2, line 45 to column 3, line 8). The caller ID server 124 is

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connected to an Internet protocol network 128, and to a user computer 130 (column 3, lines 39-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Rogers reference with Gurbani's teaching so that the user-accessible call-log [data logging unit] would have been within a switched telephone network, because placing the user-accessible call-log within or outside a switched telephone network would have been a matter of design choice.

8.2 Regarding claim 19, the Rogers reference, modified by Gurbani, the user-accessible call-log inherently includes a database for storing the caller identifying information, and wherein the database is local to a SSP of a switched telephone network. In the modified Rogers reference, the database is local to a SCP, which in turn, is local to a SSP.

8.3 Regarding claim 20, the Rogers reference, modified by Gurbani, the user-accessible call-log inherently includes a database for storing the caller identifying information, and wherein the database is local to a SCP.

8.4 Regarding claim 21, the Rogers reference, modified by Gurbani, Rogers teaches prompting the subscriber with a message "call log" at the top-left corner of the call log window.

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8.5 Regarding claim 22, the Rogers reference, modified by Gurbani, Rogers teaches options of reviewing and editing the user-accessible call-log (column 42 line 64 to column 43 line 3).

8.6 Regarding claim 23, the Rogers reference, modified by Gurbani, Rogers teaches options menu is a pull down screen menu (figure 9).

8.7 Regarding claim 24, the Rogers reference, modified by Gurbani, Gurbani further teaches that caller identifying information can be deleted (column 3, lines 64-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Rogers reference with Gurbani's teaching so that command menu would have included a delete command for deleting the caller identifying information, because such modification would have saved memory space.

8.8 Regarding claim 25 and 26, the Rogers reference, modified by Gurbani, Rogers teaches storing caller identifying information in a user-accessible call-log (column 42, lines 11-13 and 24-26), which is save in a call management computer, and inherently in the computer's hard disk.

9. Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers US Patent 5,946,386 in view of Greco US Patent No. 5,568,540.

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Rogers discloses a call management system and voice mail system in figure 1.

Rogers teaches accessing a user-accessible call-log, which stores call related information [caller identifying information] (column 42, lines 11-13 and 24-26), including caller IDs (column 23, lines 16-20; column 25, lines 18-24; figure 9), via a user [subscriber] computer remotely connected to the system through Internet (column 6, lines 59-62; column 7, lines 13-19; column 8, lines 53-58). Rogers teaches viewing the call related information (figure 9), which has an indicator "VM" indicating a call sent to voice mail (figure 9, call indicator 905; column 42, lines 38-43), Rogers also teaches retrieving a voice message by clicking a mouse, but fails specifically to teach the voice message is played on the speaker of the computer.

However, Greco discloses a multi-media messaging system in figure 1. Greco teaches retrieving a voice mail message from server 38 over a local area network by clicking on the open button 190 (figure 2) after highlighting the message (column 5 lines 2-8), and the message can be listened to on the speaker of a computer (column 5, lines 31-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Rogers reference with Greco's teaching so that a subscriber would have been able to listen to a voice message on his computer's speaker via internet, because such modification would have clarified the teaching of Rogers and enabled a subscriber to listen to his voice mail on his computer's speaker without making a telephone call.

10. Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers US Patent 5,946,386 in view of Bowater US Patent No. 6,282,269.

Rogers discloses a call management system and voice mail system in figure 1. Rogers teaches accessing a user-accessible call-log, which stores call related information [caller identifying information] (column 42, lines 11-13 and 24-26), including caller IDs (column 23, lines 16-20; column 25, lines 18-24; figure 9), via a user [subscriber] computer remotely connected to the system through Internet (column 6, lines 59-62; column 7, lines 13-19; column 8, lines 53-58). Rogers teaches viewing the call related information (figure 9). Rogers also teaches, but fails to teach calling back at least one caller via Internet.

However, Bowater discloses an Internet computer phone (figure 3; column 6, lines 8-16; figure 5; column 7, lines 12-23), which is able to leave and retrieve voice mail messages (figure 6; column 10, lines 20-23; column 12, lines 37-51) over the Internet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Rogers reference with Bowater's teaching so that a subscriber's computer would have been an Internet phone, which would have been able to initiate or receive telephone calls over the Internet, because such modification would have enabled a subscriber to use one single device (computer) to view his call related information and to initiate or receive telephone calls.

***Response to Amendment***



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11. The declaration filed on July 23, 2002 under 37 CFR 1.131 has been considered but is ineffective to overcome the Gurbani reference.

11.1 The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Gurbani reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Exhibits 1-4 fail to show that the concept was conceived before 8/18/98. No date(s) regarding when the concept was conceived can be found in those documents. Therefore, the statement on the Declaration "Prior to August 8, 1009, aspects of the invention of the claims were first conceived by one of our inventor" was just conclusions and no there are facts to support this statement.

Further, Exhibits 1-4 fail to show the concept of the claim invention. For example, Exhibits 1 and 2 fail to mention the Internet at all. Exhibits 3 and 4 merely mentioned the telephonic system and the Internet, but fail to disclose the interaction between the telephonic system and the Internet, such as "using one of a SS7 or a wireless link" as claimed in claim 4, or "a line peripheral, an intelligent peripheral and a gateway" as recited in claims 6 and 8.

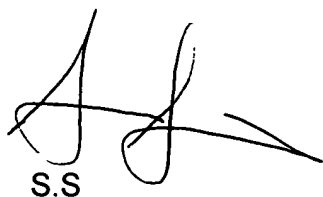
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11.2 The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Gurbani reference to either a constructive reduction to practice or an actual reduction to practice.

There is no evidence which shows due diligence from the applicants.

**Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.



S.S

9/27/2002

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

